



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

PD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/873,978 06/12/97 KAYYEM

J A-63761-1/RF

HM22/0119

FLEHR HOHBACH TEST
ALBRITTON & HERBERT
FOUR EMBARCADERO CENTER
SUITE 3400
SAN FRANCISCO CA 94111-4187

EXAMINER

MARSCHEL, A

ART UNIT

PAPER NUMBER

1655

22

DATE MAILED:

01/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/873,978

Applicant(s)

Kayyem et al.

Examiner

Ardin Marschel

Group Art Unit

1655



☒ Responsive to communication(s) filed on Sep 13, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 47-67 is/are pending in the applicat

~~On the above, claim(s) 1-46 have been canceled.~~ ~~is/are withdrawn from consideration~~

☒ Claim(s) 49, 52-54, 57, and 62-67 is/are allowed.

☒ Claim(s) 47, 48, 50, 51, 55, 56, and 58-61 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, ~~PTO-1449~~ (1 sheet)

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Applicants' arguments, filed 9/13/99 and 11/4/99, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR § 1.821 through 1.825 because no submission of computer readable form sequences etc. has been submitted. Note that a sequence is given at least on page 112, line 14, of the instant specification. Applicants are given the same response time regarding this failure to comply as that set forth to respond to this office action.

In view of the papers, filed 9/13/99, it has been found that this application, as filed, through error and without any deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 C.F.R. § 1.48. The inventorship of this application has been changed by the addition of Thomas J. Meade.

The proposed correction to Figure 1 has been approved by the

Examiner. Formal drawings are yet to be filed.

Claims 50 and 55 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 50 contains NEW MATTER regarding several of the B-D moieties therein listed. Particularly, written support has not been found for -CS-O- or -O-CS-.

Claims 47, 48, 50, 51, 55, 56, and 59-61 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 47 and 48 cite atoms therein but a protected atom is not an oligomer. The metes and bounds of what the oligomer contains or at least consists of is vague and indefinite in that it is not defined in the claims and an oligomer cannot be a single atom, even if protected. Clarification via clearer claim wording is requested.

Claims 50 and 55 give D as a "preferably..." in the penultimate line of claim 50 which causes these claims to be vague and indefinite as to the metes and bounds of D regarding what is claimed beyond "preferably...". Something beyond

"preferably..." is deemed suggested by that phraseology.

Clarification is requested via clearer claim wording.

In claim 51 several R groups may be attached to the carbons surrounding the G bond. It is noted that the last three lines of claim 51 defines what R is but does not clarify whether R is independently selected for each occurrence or whether it is uniform within each embodiment. This same issue exists for n being greater than 1 regarding C-G-C moieties. Clarification via clearer claim wording is requested. This is also a concern for instant claim 50 as to what is meant when multiple B-D moieties exist via e being more than 1. This same concern exists for multiple groups in claims 55, 56, and 59-61.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 58 is provisionally rejected under the judicially

created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 10, 16, 17, and 54 of copending application Serial No. 08/743,798. Although the conflicting claims are not identical, they are not patentably distinct from each other because the respective claims contain common embodiments directed to electrodes with nucleic acid and a passivation agent or agents.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 49, 52-54, 57, and 62-67 are allowed.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Serial No. 08/873,978

- 6 -

Art Unit: 1655

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

January 18, 2000

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER